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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/812,690		Keisuke Tamura	53375/1385	1879

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WASHINGTON, DC 20005

EXAMINER

FINEMAN, LEE A

ART UNIT	PAPER NUMBER
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2872

DATE MAILED: 08/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/812,690

Applicant(s)

TAMURA ET AL.

Examiner

Lee Fineman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11, 34, 43, 44, 47 and 57-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11, 43, 44 and 47 is/are allowed.
- 6) ☒ Claim(s) 34 and 57-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 25 May 2004 has been entered in which claims 11, 34, 44 and 47 were amended, claims 9, 12-16, 28-33, 35-42, 45-46 and 48-56 were cancelled and claims 57-60 were added. Claims 11, 34, 43-44, 47 and 57-60 are pending.

Claim Objections

2. Claims 57 and 58 are objected to because of the following informalities:

In claim 57, lines 12-13, the limitations "said total reflection prism" and "said total transmission prism" lack antecedent basis.

Further claim 58 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 58 only adds the limitations of a total reflection prism and a total transmission prism, which are already in claim 57 (although lacking antecedent basis) from which claim 58 depends.

Appropriate correction is required.

Double Patenting

3. Applicant is advised that should claim 34 be found allowable, claims 58 and 60 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 34 and 57-61 are rejected under 35 U.S.C. 102(b) as being anticipated by Watanabe et al., Japanese Patent Publication No. JP 11287956 A.

Watanabe et al. disclose a microscope (fig. 1) comprising an objective lens (7); an ocular lens (in 22) provided in an observation optical path of the objective lens (fig. 1); a first optical component (29, fig. 2), which is a total transmission prism, for directing light reflected from a sample (S) away from the optical observation path in a direction (β) other than the ocular lens; a second optical component (27, fig 2), which is a total reflection prism, for directing light reflected from the sample along the observation optical path (α) towards the ocular lens; and a moving frame (26, fig. 2) on which the first optical component and the second optical component are provided, the moving frame exclusively placing either the first optical component or second

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optical component in the observation optical path (fig. 2); and in the moving frame, the distance Y (the length of component 28), which is the distance between the first optical component and the second optical component, is set to be longer than a half of the diameter X, which is the maximum diameter of a light flux of said observation optical path (the length of component 28 or Y must be more than half the maximum diameter X of light bundle so the entire image is seen when passing through component 28 and the device functions correctly).

Allowable Subject Matter

6. Claims 11, 43-44 and 47 are allowed.

7. The following is an examiner's statement of reasons for allowance:

Claim 11, 43-44 and 47 are allowable over the prior art for at least the reason that the prior art fails to teach and/or suggest all the features of the inverted microscope, including an objective; first (excitation) and second (laser) light source; first (total reflection prism), second and third optical element; total transmission prism; image-forming lens and lens holder; imaging port; and moving mechanism, as set forth in the claimed combination. Although certain individual components are met by the prior art, there would be no suggestion or teaching to combine by the prior art to get the entire combination claimed.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue

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fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Response to Arguments

8. Applicant's arguments with respect to new claims 57-60 have been considered but are moot in view of the new ground(s) of rejection.

9. After careful review of the claims, it is found that a rejection is appropriate for claim 34. The examiner regrets any inconvenience caused by this action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lee Fineman whose telephone number is (571) 272-2313. The examiner can normally be reached on Monday - Friday 7:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



LAF

August 2, 2004


MARK A. ROBINSON
PRIMARY EXAMINER